

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Bates <i>et al.</i>	Conf. No.:	9951
Serial No.:	10/062,102	Art Unit:	2173
Filing Date:	01/31/2002	Examiner:	Basom, Blaine T.
Title:	METHOD AND SYSTEM FOR SELECTING MULTIPLE SETS OF DATA IN AN APPLICATION	Docket No.:	END920010052US1 (IBME-0027)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-26 are pending in this application.

Turning to the rejection, in the Final Office Action, claims 1, 9, 17, 21 and 23 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office has stated that the specification does not explicitly disclose or suggest that the method is adapted to allow selecting of the second set of data anywhere within the application, irrespective of a location of the first set of data. Applicants respectfully submit that page 10, line 11 through page 11, line 24 teach that the second set of data may be, *inter alia*, contiguous with, non-contiguous with, or within the first set of data and specifies

manners for performing this second selection. To this extent, Applicants' original specification complies with the written description requirement.

Claims 1-26 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Carroll (U.S. Patent No. 6,683,631), hereafter "Carroll." Applicants submit that this rejection is clearly not proper and without basis because at least one claim limitation is not met by the combined features of the references cited by the Office. As argued in the November 8, 2006 Amendment, the cited references fail to teach or suggest each and every element of independent claim 1. In particular, Carroll fails to teach selecting a second set of data within the application, wherein the first set of data remains selected during the selection of the second set of data, wherein the method is adapted to allow selecting of the second set of data anywhere within the application irrespective of a location of the first set of data. November 8, 2006 Amendment, page 9, final paragraph. In contrast, Carroll teaches selecting an initial region and then making a selection that either extends the region by adding contiguous regions or removes material from within the initial region. To this extent, the selection of Carroll that the Office equates with the second set of data of the claimed invention is not independent of the initial selection, but must be within or contiguous with it. Furthermore, as argued with respect to dependent claims 6 and 13, Carroll does not teach that the method is adapted to allow selection of the second set of data that is non-contiguous with the first set of data. Rather, as argued above, Carroll's second selection is always contiguous with the first.

As further argued in the November 8, 2006 Amendment, Carroll also fails to teach selecting, in a distinctive manner, a portion of one of the selected sets of data, wherein the one of the selected sets of data remains selected during the selection of the portion. See November 8, 2006 Amendment, page 11, beginning with first full paragraph. Instead, the passage of Carroll

cited by the Office teaches only that selected text is different in appearance from non-selected text. This does not teach the claimed limitation of a selected region of text with a distinctly displayed second region of text comprising a portion thereof.

Accordingly, the Office has failed to state a prima facie case of anticipation, and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

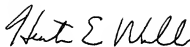
With respect to the rejections of independent claims 9, 17, 21 and 23, Applicant notes that each claim includes a feature similar in scope to the writing to those discussed herein. Further, the Office relies on the same arguments and interpretations of the cited references as discussed above with respect to claim 1. To this extent, Applicant herein incorporates the arguments presented above with respect to claim 1, and respectfully request withdrawal of the rejections of these claims for the above-stated reasons.

The dependent claims are believed to be allowable based on the above arguments regarding the claims from which they depend, as well as for their own additional features.

With further regard to the rejection as a whole, Applicant notes that the Office's rejection of independent claim 1 seeks to combine five different references to support its obviousness rejection, and six or more references for other claims. To this extent, Applicant submits that it is unfathomable how the Office can maintain its contention that there is motivation or suggestion in the references themselves or elsewhere to combine such diverse references. This is further accentuated by the fact that each of the references performs a vastly different task. Accordingly, Applicants submit that the combinations that underlie the Office's rejections are flawed.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Hunter E. Webb

Rcg. No.: 54,593

Date: April 24, 2007

Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, New York 12207
(518) 449-0044
(518) 449-0047 (fax)

RAD/hew